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#31

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Obara

Serial No. : 09/608,260

Filed : June 30, 2000

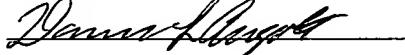
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I hereby certify that this paper or fee is being deposited with the United States Postal Service as Express Mail Post Office to Addressee service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, Washington, D.C. 20231. Name: Donna L. Angotti

Examiner : Andrews

Signature: 

Group Art Unit : 1742

Attention: Office of Petitions
Commissioner for Patents
Box DAC
Washington, D.C. 20231

Petition for Revival of an Application for Patent Abandoned Unintentionally

Under 37 CFR 1.137(b)

Or Alternatively

**Petition to Convert an Improper Continued Prosecution Application into a Continuing
Application Under 37 CFR 1.53(e)**

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01 FC:122 130.00 CH

**OFFICE OF PETITIONS
DEPUTY A/C PATENTS**

The above-identified application became abandoned for failure to file a timely and proper reply to an Office Action mailed on March 22, 2001, when Applicant filed an Improper Request for Continued Prosecution Application. (See the enclosed copy of the Notice of Abandonment.)

On September 24, 2001, Applicant has filed a timely (September 22, 2001 fell on a Saturday) petition for a three month extension of time, a request for a CPA, a change of address and attorney docket number, and a receipt for facsimile transmitted CPA. However, Applicant

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has failed to realize that the Request for a CPA was improper because the application was filed on June 30, 2000, i.e., after May 29, 2000.

Under the MPEP 706.07(h), where an applicant files a request for a CPA of a utility application filed on or after May 29, 2000, the Office will automatically treat the improper CPA as a Request for Continued Examination under 37 CFR 1.114. To satisfy requirements of the 37 CFR 1.114, however, the RCE has to be filed after closing of prosecution. In the present application, the Office Action of March 22, 2001 was not a final rejection, therefore a request for an RCE would not have been proper either. Therefore, the improper request for a CPA was not converted by the Office into a request for an RCE.

Applicant understands that neither the rules in 37 CFR nor the MPEP provide for automatic conversion of an improper application filed under 37 CFR 1.53(d) into a proper application under 37 CFR 1.53(b), where a request for an RCE would not have been proper, as a matter of right. However, Applicant directs the Commissioner's attention to the underlying policy that lead to the enactment of Rule 1.114. According to the Request for Continued Examination Practice and Changes to Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), the RCE practice was intended to simplify the practice of continuing examination of patent applications at Applicant's request. The new RCE practice did not intend to penalize an applicant who required more than six months to contemplate a response to a non-final Office Action, as in the present case where Applicant wishes to provide test data. In fact, the Interim Rule 1.114 did not require that prosecution in an application was closed for an applicant to obtain continued examination under this section. The harsh consequences encountered by the Applicant in this case, including abandonment and loss of rights, were not contemplated by the rule changes. The rule changes

were intended to simplify continuing prosecution and not to result in loss of rights or to "trip up" the unwary practitioner with a technicality regarding the form of a Continuation Application.

Based on the above, Applicant hereby petitions to convert an improper Request for a Continued Prosecution Application under 37 CFR 1.53(d) into a Continuing Application under 37 CFR 1.53(b). A true copy of the above referenced complete non-provisional application and an amendment not previously entered are enclosed with the present petition. A copy of the executed declaration filed in the above referenced application is submitted with the continuation application. The Commissioner is hereby authorized to debit our deposit account, Account No. 500675, in the amounts of \$130 for a petition fee, \$740 for the continuing application filing fee, and \$168.00 for two additional independent Claims, totaling \$1,038.00. Accordingly, all the parts of a Continuing Application under 37 C.F.R. 1.53(b) are provided.

Alternatively, in accordance with 37 C.F.R. §1.137(b), Applicant hereby petitions for a revival of the above-captioned patent application. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

Since this utility application was filed after June 8, 1995, no terminal disclaimer is required.

The reply to the above noted Office Action in the form of a continuing application is enclosed herewith.

In any event, Applicant petitions for a pending Continuing Patent Application entitled to the effective filing date of the now abandoned Serial No.: 09/608,260, filed June 30, 2000.

The Commissioner is hereby authorized to debit our deposit account, Account No. 500675, for a required petition fee of \$1,280. However, as explained further above, Applicant

respectfully requests the Commissioner to, instead, grant the Applicant's petition under 37 CFR 1.53(e) and charge the deposit account, Account No. 500675, for \$1,038.00 (the petition fee, the filing fee, and the fee for two additional independent Claims).

As all of the requirements of 37 CFR 1.137(b) have been complied with in the present petition, a revival of the present application is respectfully sought and is believed to be fully warranted.

Should any extensions of time or further fees be considered necessary in connection with this communication, the necessary extensions and payment of the further fees are requested. The Commissioner is directed to debit our deposit account, Account No. 500675, for any amounts required, and is also directed to credit any overpayments thereto.

Respectfully submitted,

Schulte Roth & Zable LLP
Attorneys for Applicant
919 Third Avenue
New York, NY 10017
(212)756-2000

By 
Donna L. Angotti
Reg. No. 32,679

Dated: October 30, 2001
New York, NY



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARK
Washington, D.C. 20231

H. H. H.

APPLICATION NUMBER	DAY/ MONTH	YEAR	FILING DATE	CODE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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OBARA

861975-0032

JOEL E. LUTZKER, ESQ.
SCHULTE ROTH & ZABEL LLP
919 THIRD AVENUE
NY NY 10022

1M22/0927

EXAMINER
ANTHONY J. PAPALEO

RECEIVED

OCT 01 2001

ART UNIT

PAPER NUMBER

SCHULTE ROTH & ZABEL LLP

DATE MAILED:

10

09/27/01

NOTICE OF ABANDONMENT

This application is abandoned in view of:

Applicant's failure to timely file a proper reply to the Office letter mailed on _____.

A reply (with a Certificate of Mailing or Transmission of _____) was received on _____, which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.

A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 to the final rejection.

(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; or (2) Notice of Appeal).

No reply has been received.

Applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).

The issue fee (with a Certificate of Mailing or Transmission of _____) was received on _____.

The submitted issue fee of \$ _____ is insufficient. The issue fee required by 37 CFR 1.18 is \$ _____.

The issue fee has not been received.

Applicant's failure to timely file new formal drawings as required in the Notice of Allowability (PTOL-37).

Proposed new formal drawings (with a Certificate of Mailing or Transmission of _____) were received on _____.

The proposed new formal drawings filed _____ are not acceptable.

No proposed new formal drawings have been received.

The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

The reason(s) below: CPA is not proper because this application was filed after May 29 2000. See PTO/15B/29(10-00) CPA Request Transmittal Form.

MELVYN ANDREWS

PRIMARY EXAMINER

Melvyn Andrews

U.S. GPO: 1998-447-856/15022